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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,364	06/04/2001	Naomi Go	09793822-014	3070
7590	08/05/2004			
David R Metzger Sonnenschein Nath & Rosenthal P O Box #061080 Wacker Drive Station Chicago, IL 60606-1080			EXAMINER TO, BAOQUOC N	
			ART UNIT 2172	PAPER NUMBER
			DATE MAILED: 08/05/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/857,364	GO, NAOMI	
	Examiner Baoquoc N To	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 25 June 2004.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,4-6,8-10,12-14 and 16-22 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,4-6,8-10,12-14 and 16-22 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: 90C.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT      PAPER

7

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Please withdraw the Finality of the Office Action mailed on December 5, 2003 and reset the time from the mailing date of this correspondence.



JEAN M. CORRIELUS  
PRIMARY EXAMINER

**DETAILED ACTION**

1. Claims 1, 8, 12-13, 17, and 20-22 are amended in the amendment filed on 06/25/2004. Claims 1,4-6,8-10,12-14 and 16-22 are pending in this application.

***Response to Arguments***

2. Applicant's arguments with respect to claim 1, 12-13 and 20-22 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-6, 8-10, 12-14 and 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takano (US. Patent No. 5,884,301) in view of Minami et al. (US. Patent No. 6,212,521).

Regarding on claim 1, Takano teaches an information processing apparatus for providing position information indicative of a position of information, comprising:

A database storing discrimination information (index literature, sport) (fig. 2) assigned to an object constituting the homepage (node) and said position information (server) corresponded (col. 3, lines 46-64);

Collections means for collecting said discrimination information of the object constituting of the information from said information which is represent on a network (a table 20 includes, columns of, at least, node identifiers, indexes each indicating a genre of the contents of a content files corresponding to a node identifier) (col. 4, lines 1-5), and the position information of the information (server), and registering the collected discrimination information and position information corresponded in said database (col. 4, lines 1-40);

Receiving means for receiving discrimination information assigned to an object constituting information transmitted from a terminal (the server received these registered of keywords in the table) (fig. 2);

Search (retrieve) means for searching said position information (server 2) corresponded to discrimination information from said terminal from a database storing discrimination information assigned to the object constituting information (keyword sport) and said position information with respect to the information corresponded (server 2, node 040) (col. 4, lines 21-27);

Preparing means for preparing a list of said position information searched (col. 4, lines 41-45); and

Transmission means for transmitting said list of position information (col. 4, lines 45-50).

Takano does not explicitly teach issue means for issuing said discrimination information not registered in said database in response to the request from said terminal. However, Minami teaches, "that a user has issued a data retrieval request for some non-registered data. This teaches in fact the worst situation, where all data management servers in the system are forced to conduct data searches which would end up with totally fruitless results" (col. 3, lines 25-30). This teaches the system allows the user to retrieve the non-register data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano's system to include retrieval of non-register data as taught by Minami in order to provide the system of non-registered data although it is the fruitless results.

Regarding on claims 4, Takano teaches the collects means collects related to said object, and registers said position information and related information corresponding to said discrimination information in said database (col. 4, lines 1-40).

Regarding on claim 5, Takano teaches related information includes a keyword used to search discrimination information assigned to said object (col. 4, lines 21-26);

Said receiving means receives said key word transmitted from said terminal (col. 4, lines 16-20);

Said search means searches said discrimination information corresponded to the related information including said key word received by said receiving means (col. 4, lines 15-21); and

Said transmission means transmits the search result of said discrimination information to said terminal (col. 4, lines 20-26).

Regarding on claim 6, Takano teaches addition means for adding the importance degree to said object, wherein said preparing means prepares a list of said position information searched on the basic of said importance degree (col. 4, lines 41-45).

Regarding on claim 8, Takano teaches information is a file described in a predetermined description language (html web document) (col. 4, lines 1-10).

Regarding on claim 9, Takano teaches predetermined description language is HTML (col. 4, lines 1-10).

Regarding on claim 10, Takano teaches position information is URL (col. 4, lines 1-4).

Regarding on claims 12 and 13, Takano teaches a recording medium in which a program for causing a computer to execute information processing for providing position information indicative of a position of information, a program being recoded, said program comprising:

Searching (retrieve) step for searching position information (server 1) transmitted from a terminal corresponded to discrimination information from said terminal from a database storing discrimination information assigned to the object constituting information (server 2, node 040) and said position information with respect to the information corresponded (col. 4, lines 21-27);

Preparing step for preparing a list of said position information searched (col. 4, lines 41-45); and

Takano does not explicitly teach issue means for issuing said discrimination information not registered in said database in response to the request from said

terminal. However, Minami teaches, "that a user has issued a data retrieval request for some non-registered data. This teaches in fact the worst situation, where all data management servers in the system are forced to conduct data searches which would end up with totally fruitless results" (col. 3, lines 25-30). This teaches the system allows the user to retrieve the non-register data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano's system to include retrieval of non-register data as taught by Minami in order to provide the system of non-registered data although it is the fruitless results.

Regarding on claim 14, Takano teaches input for inputting said discrimination information transmitted to said transmission means (col. 4, lines 45-50).

Regarding on claim 16, Takano teaches request means for requesting said server to search said discrimination information by a keyword (sport) (col. 4, lines 28-41).

Regarding on claim 17, Takano teaches information is a file described in a predetermined description language ( ).

Regarding on claim 18, Takano teaches predetermined description language is HTML (col. 4, lines 1-4).

Regarding on claim 19, Takano teaches position information is URL (col. 4, lines 1-4).

Regarding on claims 20-21, Takano teaches an information processing method for requesting a server for providing position information indicative of a position of information said position information, comprising:

Transmission step for transmitting discrimination information assigned to an object constituting information to said server (col. 4, lines 45-50);

Receiving step for receiving a list of said position information with respect to said information constituted from said object to which the discrimination information transmitted from said server corresponding to the transmission of said discrimination information is assigned (the server received these registered keywords in the table) (fig. 2);

Display control (display) step for displaying the list of said position information (fig. 3); and

Takano does not explicitly teach issue means for issuing said discrimination information not registered in said database in response to the request from said terminal. However, Minami teaches, "that a user has issued a data retrieval request for some non-registered data. This teaches in fact the worst situation, where all data management servers in the system are forced to conduct data searches which could which would end up with totally fruitless results" (col. 3, lines 25-30). This teaches the system allows the user to retrieve the non-register data. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Takano's system to include retrieval of non-register data as taught by Minami in order to provide the system of non-registered data although it is the fruitless results.

Claim 22 is rejected same reason as claims 21 and 22, in addition Takano also teaches terminal comprising second transmission for transmitting discrimination

information assigned to an object constituting information to said server (server1); second receiving means for receiving a list of said position with respect to said information constituted from said object to which the discrimination information transmitted from said server corresponding to the transmission of said discrimination information is assigned (server 2) (col. 4, lines 20-26).

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Information***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is (703) 305-1949 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at (703) 305-9790.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231.

The fax numbers for the organization where this application or proceeding is assigned are as follow:

(703) 872-9306 [Official Communication]

Hand-delivered responses should be brought to:

Crystal Park II  
2121 Crystal Drive  
Arlington, VA 22202  
Fourth Floor (Receptionist).

Baoquoc N. To

, 2004



JEAN M. CORRIELUS  
PRIMARY EXAMINER